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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Citicorp
v.
Brooklyn Federal Savings Bank

Opposition No. 101,395
to application Serial No. 74/560,835
filed on August 15, 1994

Richard Z. Lehv and Joseph R. Molko of Fross Zelnick
Lehrman & Zissu, P.C. for Citicorp.

Howard B. Barnaby and Ned W. Branthover of Robin Blecker
& Daley for Brooklyn Federal Savings Bank.

Before Sams, Chief Administrative Trademark Judge, and
Hanak and Rogers, Administrative Trademark Judges.

Opinion by Rogers:

Applicant Brooklyn Federal Savings Bank has applied
to register THE ANYTIME/ANYWHERE CARD as a mark for
"automated teller machine services." The involved
application was filed August 15, 1994 on the basis of
applicant's stated intention to use the mark in commerce.
Although the record is clear that applicant shortly

thereafter began using the mark, the application was published for opposition without prior amendment to assert use of the mark in commerce. The application includes a disclaimer of exclusive rights in the word CARD.

Opposer Citicorp, under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), has opposed the application. Opposer asserts that it has priority of use of the slogan ANYTIME, ANYWHERE, ANY WAY¹ for various banking services and that there will be a likelihood of confusion among consumers, or they will be mistaken or deceived, by concurrent use of its and applicant's marks in the marketplace. Opposer has not registered the slogan on which it bases its opposition.

The notice of opposition includes the following allegations:

3. Opposer is and has been for many years an internationally known provider of banking and financial services, including electronic banking and financial services provided by means of automated teller machines.

4. Since at least as early as May 10, 1992, Opposer has used and continues to use the mark ANYTIME, ANYWHERE, ANY WAY in connection with its consumer banking and mortgage services,

¹ The record is clear that opposer actually uses those three words in a variety of formats. At this point, we refer to the claimed mark as opposer has in its pleading.

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including, but not limited to, automated teller machine services. ...

Opposer also alleges that the slogan "has become exclusively associated with opposer" and that applicant's use of its mark for its services "may mistakenly be thought by the public to be a use by Opposer or with its authorization, permission, consent or license." Opposer claims it "will be gravely damaged by registration" of applicant's mark. Attached to the notice of opposition are various promotional materials; of course, these are part of the record only insofar as they may have been properly introduced during trial.

Applicant, in its answer, admits its address and that it is a federally chartered savings bank, that opposer "is a well known banking/financial institution," admits that opposer attached certain materials to its notice of opposition, but otherwise expressly or effectively denies the allegations of the notice. In fact, applicant even denies allegations which are not expressly stated in the notice but may be viewed as implicit, e.g., applicant denies that "THE ANYTIME/ANYWHERE CARD, as used by Applicant, is substantially similar to Opposer's 'ANYTIME, ANYWHERE, ANY WAY' designation."

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Applicant not only denies that opposer's use of ANYTIME, ANYWHERE, ANY WAY "qualifies as service mark use, trademark use, or any analogous use," but applicant also asserts as an affirmative defense that opposer has failed to demonstrate any proprietary rights in the slogan and that, as used by opposer, it is solely descriptive and does not serve as an indicator of origin. As an additional affirmative defense, applicant asserts that opposer has failed to plead or show that its slogan is inherently distinctive or has acquired distinctiveness. Finally, applicant asserts that there has been a period of concurrent use of the parties' respective designations without any instances of actual confusion and therefore there is no likelihood of confusion.

Following a trial during which each party offered testimony and exhibits, and each party filed a notice of reliance, the case was fully briefed. Though some objections were made during the taking of testimony, none was renewed in the briefs. Accordingly, all the evidence may be considered for whatever probative value it has. An oral argument was held in which each party was represented and made demonstrative use of evidence in the record.

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Opposer, not being the owner of a registered mark, "must prove he has proprietary rights in the term he relies upon to demonstrate likelihood of confusion as to source, whether by ... prior use of a technical 'trademark,' prior use in advertising, prior use as a trade name, or whatever other type of use may have developed a trade identity." Otto Roth & Company, Inc. v. Universal Foods Corporation, 640 F.2d 1317, 1320, 209 USPQ 40, 43 (CCPA 1981). This proof involves two elements. First, opposer must prove its proprietary right and, second, the right must have existed prior to the filing date of applicant's involved application. Levi Strauss & Co. v. R. Josephs Sportswear Inc., 28 USPQ2d 1464, 1467-68 (TTAB 1993).

The relevant evidence bearing on the question whether opposer has established existence of a proprietary right in ANYTIME, ANYWHERE, ANY WAY prior to the filing date of applicant's application consists of the June 1, 2000 testimony deposition of Steven Hancock and exhibits thereto.² Accordingly, our first consideration is to review the Hancock testimony and exhibits for evidence that may tend to establish any

² The only other evidentiary submission by opposer is a notice of reliance on portions of a discovery deposition and on certain interrogatory responses by applicant.

proprietary interest of opposer prior to August 15, 1994, the filing date of applicant's application.

The testimony includes the following:

Q. Has Citibank³ ever used the slogan "anytime, anywhere, any way"?

A. Yes.

Q. When were you first aware of its use?

A. My sense - it was about ten years ago would be my - we've been using it extensively over the years. Approximately ten years ago.

Most of the direct testimony was utilized to identify and introduce 81 exhibits.⁴ Applicant, with its brief, submitted a chart that it asserts is a summary of opposer's exhibits [all of which were offered into evidence during the Hancock deposition]. Opposer, in its reply brief, objected to our consideration of this chart. We agree with opposer that the quantity of evidence is not so great that review of each exhibit would be considered onerous. In fact, each exhibit has been

³ The relationship between Citicorp and Citibank is not explained in the notice of opposition or opposer's brief. There is an oblique reference to a name change in applicant's cross-examination of Mr. Hancock, and the parties have effectively treated Citicorp and Citibank as one. So have we.

⁴ The exhibits number 1-82, but there was no exhibit numbered 67. Thus, there are 81 exhibits to the Hancock testimony.

reviewed in conjunction with reading of the Hancock testimony transcript.

On the other hand, we agree with applicant that the Hancock testimony regarding ads, brochures and other items most often involved cursory identification of exhibits and did not provide, as put by applicant, "details as to quantity printed, date of distribution and, most importantly, whether any of the exhibits were currently in use." Applicant Brief p. 7. We also note that Mr. Hancock did not appear to identify the distribution date for brochures and similar materials, or the publication dates for ads, from personal knowledge or reference to written records but, rather, from notations, often copyright notices, on the exhibits. Hancock dep. pp. 82-84. Frequently, he did not testify to any date of distribution or publication, even when a copyright notice or other date would be on the exhibit. We accept, for purposes of our review of the Hancock exhibits, that each brochure, statement insert or "buck slip,"⁵ booklet, newsletter, and the like was actually produced no later than the date included thereon, whether or not Mr. Hancock read such date into the record. However, where,

⁵ A buck slip is a one-page printed promotional slip used as a statement insert or handout. Hancock dep. p. 19.

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as in most instances, the date is only a year, we do not consider the distribution date to be prior to the last day of that year. Further, the probative value of most of the exhibits is diminished because of the absence, except in a very few instances, of testimony about the number of copies of each piece printed and the lack of substantial first hand knowledge of the witness about actual distribution.⁶

We have sorted the exhibits to Mr. Hancock's testimony into four groups and discuss them each in turn. Our initial discussion of these groups of exhibits puts aside, for the moment, whether they actually would be perceived as featuring opposer's purported slogan as a mark.

Group one consists of exhibits 48-66 and 68-80. These are irrelevant to our determination whether opposer acquired a proprietary interest in ANYTIME, ANYWHERE, ANYWAY prior to applicant's filing date, because they are all dated 1995 or later; or they bear no date at all and

⁶ As with his testimony regarding date of distribution of a promotional piece, Mr. Hancock primarily relied on information on each piece to discern the market in which it was used. Hancock dep. pp. 82-83.

are unsupported by testimony regarding date of distribution or publication.⁷

Group two consists of exhibits 31-47. Of these, 31-40 all have a date of 1994 on them. For each of these, except exhibit 34, the year is part of a copyright notice; for exhibit 34, it was simply written on, by an unknown hand. Many of these ten exhibits have notations which appear to indicate that text and/or graphics was revised during the middle or latter part of 1994, but there is no testimony from Mr. Hancock regarding when, following revision, distribution may have begun. Accordingly, as noted earlier, we consider these probative, if at all, of use no earlier than the last day of 1994, i.e., after the filing date of applicant's application. Exhibit 42 is a transaction slip from an "express deposit" machine, with notations apparently from "Cornell Franklin VP [and] Counsel New York Banking Legal Department" indicating revision in July and August 1994. Again, however, there is no testimony regarding when, if at all, this revised slip was put to use. Exhibits 41

⁷ In addition, exhibits 68 and 69 are lengthy booklets for opposer's customers regarding account management and fees. Neither one features the purported slogan on its cover or in any internal headings or sub-headings. If it appears in the small print of either booklet, opposer has not specified where that may be. Also, exhibit 77, an imprinted plastic bag, does not

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and 43 are copies of opposer's internal newsletter from respectively, May 1994 and July 1994; exhibits 44 and 45 also are copies of this newsletter, from August 1994 and September 1994, respectively. On cross-examination, Mr. Hancock testified that opposer's internal newsletters "could" be made available to customers in bank branches. Hancock dep. pp. 62-63. In theory, then, three of these editions of opposer's newsletter [and possibly all four, if opposer distributes its newsletters in advance of their publication date] might have been available to consumers before or around the time applicant filed for registration. Exhibits 46 and 47 are ads from late 1994. Exhibits 31-47, then, are not particularly probative evidence of opposer's acquisition of a proprietary interest in ANYTIME, ANYWHERE, ANY WAY prior to applicant's filing date because we cannot be sure that they were distributed or displayed prior to applicant's filing date.

Group three consists of exhibits 19, 28, 81 and 82. Each of these was prepared as an item for internal use by opposer.⁸ We consider them in their apparent

include the purported slogan but, rather, displays "Get a Citibank Mortgage by phone Anytime, Anywhere."

⁸ The testimony of exactly when, where and how these items were used is vague at best. We construe the nature of the items liberally, there being no objections to the admissibility or

chronological order. Exhibit 82 is a videotape of a rally of Citibank employees and managers which alludes to a name change that resulted in the christening of Citibank, apparently sometime in 1992. The late-October 1992 rally apparently was intended to introduce the concepts behind a campaign titled The World of Citibanking. One speaker explained, "Citibanking is Citibank's worldwide retail branch strategy"; another explained that, to execute the strategy "...we're marrying the access and convenience story of banking - anytime, anywhere, anyway - with the kind of advice and expertise that you find with a broker or a personal banking officer." At the end of the rally, a third speaker, with "ANYTIME!" "ANYWHERE!" "ANY WAY!" projected on a screen behind her, led the assembled in a cheer, repeating the three words again and again. Exhibit 81 is a videotape of a message for employees, apparently following up on the rally and explaining the "Citibanking" campaign. It explains how the campaign will be promoted and screens a television ad. The ad does not use opposer's purported slogan but uses the terms ANYHOW ANYWHERE ANYTIME. Exhibit 19 is a list of "merchandising elements," apparently for use by marketing personnel during the

content on relevance, hearsay or other grounds, and ultimately

second quarter of 1993. The exhibit appears to list instructions for creating merchandising or advertising pieces. One section of the instructions lists the following as copy for a poster featuring a "Citicard visual": "HEAD: The Citi Never Sleeps®" "SUBHEAD: With Citicard®, bank anytime, anywhere, any way you want." "LEGALS: [information about copyright notice, particular bank, etc.]". Exhibit 28 is, according to the Hancock testimony, a collection of copies of slides, or something akin to that, for projection at a "leadership conference." One of these includes the following:

The compelling uniqueness of Citibanking, that directly addresses and meets the target market needs, is:

- The seamless integration of products and service delivery
- At all customer contact points
- Accessible anytime, anywhere, any way the customer chooses

There is no testimony that the videotape of the rally participants chanting opposer's slogan was ever seen by a customer, or that the internal videotape explaining the Citibanking campaign was ever seen by a customer. Likewise, there is no testimony that the television commercial screened in the internal videotape

weigh these items for what probative value they may have.

was ever aired. There is no testimony that the poster contemplated by exhibit 19 was ever produced. Finally, according to Mr. Hancock's testimony only "leading senior managers within Citibank" might have seen exhibit 28. In short, while these internal pieces all pre-date applicant's filing date, they are not probative evidence of technical service mark use or of any sort of public advertising or campaign which would have drawn an association between opposer's slogan and Citibank.

The fourth and final group of exhibits includes 1-18, 20-27, and 29-30, i.e., 28 of opposer's 81 exhibits. These include two newspaper ads, a variety of brochures, "buck slips," an ATM receipt, and a booklet titled "Deposit Products Fee Schedule." We have grouped these together because they all are dated in 1992 or 1993 and are for distribution to customers or, in the case of the two ads, for publication in newspapers of general circulation.

We give no weight to exhibit 18, for it includes a heading and a text sentence that include only "Anytime, Anywhere" not opposer's purported slogan. We also give no weight to exhibit 27 for, although it is clear from the presence thereon of certain customer disclosure statements that it is a part of a consumer piece, it is

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just that, only a portion of a whole and Mr. Hancock could not even identify it as an ad, brochure, or anything in particular.

In sum, of opposer's 81 exhibits, the 32 in what we have identified as group one are irrelevant; the 21 in groups two and three have very little probative value, because of uncertainty as to when they were published or distributed and/or because they are materials for internal use by opposer's employees or managers; and 2 in group four are entitled to no weight because, respectively, one does not display opposer's asserted slogan and the other is only a portion of an unidentifiable whole.

We now turn to consideration of what the remaining 26 exhibits show in regard to opposer's claimed use of ANYTIME, ANYWHERE, ANY WAY as a slogan. In doing so, we keep in mind that "[i]t is well established that not every word is a trademark, and that, even though a word may be used on or in connection with goods [or services], it is not registrable unless it is used as a mark, namely, in a manner clearly calculated to project to purchasers or prospective purchasers encountering the notation in question in the applicable marketplace environment a single source or origin of the goods [or

services].” Ipcor Corp. v. Blessings Corp., 5 USPQ2d 1974, 1976 (TTAB 1988). Opposer, however, to prevail in this opposition, need not show that its use would support registration of the slogan, but must show that its use is of such a nature that it has created an association of the slogan with its goods [or services]. Id. On this record, we do not find opposer to have made such a showing.

Of the 26 exhibits we consider from exhibit group four, exhibits 4, 6, 9-17, 20-24, and 26 and 29⁹ only show the words as part of a sentence. Some of the sentences are headings, but most are within advertising text. In none of these are the words set out from the surrounding words in the sentence, as, for example, they would be if different size type or color had been used. Exhibits 1 and 30 are newspaper ads bearing the heading “How To Manage Your Money Anytime, Anywhere, Any Way You Choose.” Again, the words are not displayed in any particular way to set them apart from the surrounding words in the heading. Within the text of each of these two ads, each of the three words Anytime, Anywhere, and Any Way are used separately in the manner of subheads, and a portion

⁹ In addition, exhibits 15 and 24 are duplicates; so are exhibits 26 and 29.

of the text recites Citibank's "commitment" "to provide the most manageable means for managing your money. Anytime, anywhere, anyway." Exhibit 2 has the words ANYTIME, ANYWHERE and ANYWAY [sic] on the cover, in a stacked, vertical format. The words are the only words on the cover set forth in red type and in a different typeface from the heading. Inside the brochure, as in the ads that are exhibits 1 and 30, each of the three words is repeated as a subhead. Finally, the brochure concludes with the legend "Anytime. Anywhere. Anyway. [sic] Only Citibank has what you need to make banking so easy." [Exhibit 7 is a duplicate of exhibit 2.] Exhibit 5, a brochure, is headed with "Manage all your money" and in smaller type sets forth the separate words "Anytime" "Anywhere" and "Any way" in the nature of subheads, each associated with a different graphic element. It is unclear whether consumers would view this as one sentence with widely separated elements, or as a heading and three subheadings. [Exhibit 8 is a duplicate of exhibit 5.] Exhibits 3 and 25 each show the words in a sentence in the text of ad copy, but the words are each capitalized.

None of the exhibits in group four uses the designation "SM" in conjunction with the asserted slogan; and this is so even though many of the exhibits do use

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the statutory registration symbol, ®, or the "SM" designation with other matter in the same exhibits. In addition, the vast majority of these exhibits also utilize the purported slogan as words in a sentence. In such a manner of use, whether the sentence is a heading or in the text, the words would be perceived as having their ordinary English language meaning as "integral and natural part[s]" of the sentences. Ipco, supra, 5 USPQ2d at 1976; see also, Old Swiss House, Inc. v. Anheuser-Busch, Inc., 569 F.2d 1130, 1133, 196 USPQ 808, 810 (CCPA 1978) (Mark "buried in the body" of articles "not the type of public exposure of a mark that would be expected to have any significant impact on the purchasing public"), and In re C.R. Anthony Co., 3 USPQ2d 1894, 1895-96 (TTAB 1987) (Four-word phrase, whether written in small or larger print, would be perceived as portion of longer sentences or phrases and would not be perceived as a service mark to identify services but, rather, as part of the advertising copy). Opposer's claim that its slogan would be perceived as a mark and not merely part of advertising copy is best illustrated by exhibit 2 and, possibly, exhibit 5 [exhibits 7 and 8, being duplicates of 2 and 5, respectively, do not add any additional

support].¹⁰ Finally, the probative value of opposer's exhibits is lessened by the vague nature of the Hancock testimony and the fact that almost universally, ads, brochures, buck slips and inserts were identified by the witness as prepared for a particular market but the witness did not testify with any specificity as to the number of copies of any of these exhibits that were printed and/or the extent to which customers would have been exposed to the exhibits.¹¹

¹⁰ Exhibit 33, from among what we have included in exhibit group two, is a brochure that displays "ANYTIME. ANYWHERE. ANY WAY." twice in a manner arguably likely to be perceived as a mark, despite the failure to identify it with an "SM" designation. However, the earliest possible date on which we could consider this brochure to have been available, as derived from a notation thereon, is "9/94." For reasons already discussed, this is entitled to little probative weight on the question whether a public association was drawn between opposer's services and its asserted mark prior to applicant's filing date of August 15, 1994.

¹¹ In one of the few passages relevant to distribution, Mr. Hancock's testimony includes the following general statement:

Q. Do you have any sense of how many copies of brochures such as Exhibit Number 5 are typically printed?

A. It depends on the business. In New York when we do New York business it would be millions of copies. Again, used for handouts, used for people to be able to pick them up, used in, you know, bank work efforts, used in trade shows. Used in direct mail. If you get into some of the other businesses like the Illinois business it would be in the hundreds of thousands. If you get into small businesses it would be tens of thousands. Again, depending on the individual business.

Hancock dep. pp. 12-13.

On the record before us, opposer has not established that, prior to the filing date of applicant's application, it made use of ANYTIME, ANYWHERE, ANY WAY as a service mark. Nor do we find opposer to have proven its allegation that the slogan "has become exclusively associated with opposer," through its uses of ANYTIME, ANYWHERE, ANY WAY in a manner short of technical service mark use. Because opposer has not proved that it has prior rights in ANYTIME, ANYWHERE, ANY WAY, it cannot succeed on its claim under Section 2(d) and we need not decide the question of likelihood of confusion.

Decision: The opposition is dismissed.

Opposer argues in its brief that "millions of viewers were exposed to [the] television advertisements" featuring its asserted mark. Opposer is referring to the television advertisement screened in the videotape for internal use by opposer, exhibit 81. There is no support in the record for the assertion that "millions of viewers" saw the ad. In fact, the speaker in the videotape explains only that the ad was prepared for the markets in which Citibank does business; and Mr. Hancock, in his testimony introducing the tape, does not testify that the ad was in fact aired.